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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,530	02/17/2006	Touru Niizaki	00331063PUS1	4991
2292 7590 06/11/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER ABU ALL SHUANGYI				
ART UNIT 1793		PAPER NUMBER		
NOTIFICATION DATE 06/11/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/568,530

Applicant(s)

NIIZAKI, TOURU

Examiner

SHUANGYI ABU ALI

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/19/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5, 8, and 11-15 are rejected under 35 U.S.C. 103(a) as obvious over U. S. Patent No. 6,541,540 to Hashizume.

Regarding claims 1, 3, 5, 8 and 11-15, Hashizume discloses a powder coating composition comprising a metal flake pigment, which can be a color metallic flake having a layer of any other color pigment, an interference film or the like on the surface, and a resin. The pigment has a size of 1-100 μm and a thickness of 0.01-5 μm (col. 3, lines 51-54). Hashizume discloses that about 0.1-5 part of phosphate ester of aliphatic alcohol based on 100 part of pigment was used to coat the pigment. Hashizume further discloses that compound other than ester such as fatty acid amide may be used in pigment coating. It is the examiner's position that the interchangeability of one known compound for another (phosphate ester for fatty acid amide) that are both known for the same purpose is clearly within the scope of the skilled artisan. Although Hashizume is silent about the charge value relationship between the pigment and resin, as applicant set forth in claim 15, it is the position of the examiner that since the charge value difference is determined by the charge value of resin and charge value agent themselves, which is a property of the resin and charge value agent, thus the claimed value difference would be inherent to that of Hashizume absent clear evidence to the contrary. See MPEP 2112.

Regarding claim 2, Hashizume discloses that the pigment is aluminum flake (col.3, line 46).

Claims 1-5, 8, 11, 13 and 15 are rejected under 35 U.S.C. 103(a) as obvious over U. S. Patent No. 6,203,909 to Chassot.

Regarding claims 1-5, 8, 11, 13 and 15, Chassot discloses a powder coating composition comprising a resin and a pigment composite. The pigment composite comprise of a substrate and a colorant. The substrate is a pigment, such as mica or aluminum flake having a size of in a range of 1-500 um, coated with organic polymer such as polystyrenesulfonic acid, which is a charge control agent. (col. 2, lines 51-67, col. 3, lines 1-66; col. 5, lines 63-66).

The reference differs from Applicant's recitations of claims by not disclosing identical ranges. However, the reference discloses "overlapping" ranges, and overlapping ranges have been held to establish prima facie obviousness (MPEP 2144.05).

Although Chassot. is silent about the charge value relation between the coated pigment and resin as applicant set forth in claims 1 and 15, it is the position of the examiner that since the charge value difference is determined by the charge value of resin and charge value agent themselves, which is a property of the resin and charge value agent, thus the claimed value difference would be inherent to of that of Chassot absent clear evidence to the contrary. See MPEP 2112.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 6,541,540 to Hashizume or U. S. Patent No. 6,203,909 to Chassot., in view of U.S. Patent No. 5,270,445 to Hou.

Regarding claim 9, Hashizume or Chassot disclose a composition as applicant set forth in claim 1, but they are silent about the method of coating the pigment as applicant set forth in claim 9.

However, Hou discloses a method of coating pigment particles with polymer by dissolving polymer in a good solvent followed by adding a poor solvent to precipitate polymer on the surface of the pigment (col. 6, lines 10-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use Hou method in Hashizume pigment making motivated by the fact that the polymer particle size on the pigment surface have controllable size, surface characteristics and morphology (col. 6, lines 7-9).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 6,541,540 to Hashizume or U. S. Patent No. 6,203,909 to Chassot., in view of GB 2111522 A to Banba.

Regarding claim 10, Hashizume or Chassot disclose a composition as applicant set forth in claim 1, but they are silent about the method of coating the pigment as applicant set forth in claim 10.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use the method set forth in claim 10 to coat pigment material motivated by the fact that Banba, also drawn to the study of polymer coated metallic pigment, discloses a method of coating carrier material by adding monomers in into the

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solution and then polymerized them to make a composition of good voltage resistance (page 1, line 59-62 and line 13).

Response to Arguments

Applicant's arguments with respect to claims 1-5 and 8-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The references on the 892 are cited as art of interest because they are cumulative or less than the art relied in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/
Primary Examiner, Art Unit 1793

sa